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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/618,427

07/10/2003

David M. Van Wie

07451.0002-04000

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07/13/2010

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EXAMINER

JOHNSON, CARLTON

ART UNIT

PAPER NUMBER

2436

MAIL DATE

DELIVERY MODE

07/13/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/618,427	Applicant(s) VAN WIE ET AL.	
	Examiner CARLTON V. JOHNSON	Art Unit 2436	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38,40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38,40 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4-19-2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to application amendments filed on 4-14-2010.
2. Claims **38, 40, 41** are pending. Claims **1 - 37, 39, 42 - 53** have been canceled. Claim **38** is amended. Claim **38** is independent. This application was filed on 12-20-2002.

Response to Arguments

3. Applicant's arguments have been fully considered but they were not persuasive.

3.1 Applicant argues that the referenced prior art does not disclose, *control information* ,, *intertwined with content portions of information signal in locations based on the available bandwidth of a first communications channel*.

Moskowitz discloses the integration of a watermark and an information signal (control information) with the content signal. An information signal is integrated or intertwined with content. (see Moskowitz col 2, lines 62-65: integrates watermark, information signal or control information, and as clearly as possible to content signal; intertwined or equivalent term integrated) And, Moskowitz discloses the processing of an information signal (control information) based on bandwidth considerations. (see Moskowitz col 10, lines 11-14: highlight advantageous locations for insertion of digital watermarks; col 14, lines 5-7: measuring, generalizing, altering features determined by relationships between frequency bands (bandwidth consideration) for insertion of watermarks)

There is no disclosure within the specification or original claims for the designation of

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a "first" communications channel. (See 112 Rejections)

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim **38** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There does not appear to be any disclosure for a "first" communication channel in the specification or original claims as opposed to a second or any other numerical designation for a communication channel. The first communications channel will be interpreted as a communications channel.

Appropriate correction is required.

Claim Rejections – 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims **38, 40, 41** are rejected under 35 U.S.C. 103 (a) as being unpatentable over **Stefik et al.** (US Patent No. **5,629,980**) in view of **Moskowitz et al.** (US Patent No. **5,889,868**).

With Regards to Claim 38, Stefik discloses a rights management method comprising the steps of:

- (c) using the control information to determine whether at least part of the information signal may be copied to a second device; (see Stefik col. 34, lines 34-40: request to make one or more copies of the work (information signal, content); make copies with the same or lesser usage rights (control information)) and
- (d) copying at least part of the information signal to the second device if permitted by the control information. (see Stefik col. 34, lines 34-40: request to make one or more copies of the work (information signal, content); col. 34, lines 54-61: server transmits the requested contents and data to the client (second device); rights are transmitted)
- e) using the control information to determine whether the content portion may be rendered by the first device; (see Stefik col. 30, line 59 - col. 31, line 4: each usage may have one or more conditions which must be satisfied before the right can be exercised; verify that requirements are met for all of the parts involved in a transaction) and
- f) rendering the content on the first device if permitted by the control information.

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(see Stefik col. 36, lines 29-32: send the digital work through some kind of transducer or a display device)

Stefik discloses for a): control information comprising an indication of whether at least part of the content portion may be copied; and control information further comprising an indication of a number of times the content portion may be rendered by a given device. (see Stefik col 37, lines 18-22: number of copies in the (print) request (number of times content may be rendered or printed by a device (a given device))

Stefik does not specifically disclose for a): control information being intertwined with the content portion of the information signal, and in locations based on the available bandwidth of the first communications channel, and for b): steganographically decoding an information signal.

However, Moskowitz discloses:

a) receiving an information signal at a first device over a first communications channel, the information signal comprising a content portion and steganographically encoded control information (see Moskowitz col. 10, lines 15-18: signal includes watermark (control information); col 2, lines 26-30; col 2, lines 38-45: channels used for digital data transmission), the control information being intertwined with the content portion of the information signal (see Moskowitz col 2, lines 62-65: integrates watermark, information signal (control information), as clearly as possible to content signal; intertwined); in locations based on the

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available bandwidth of the first communications channel (see Moskowitz col 10, lines 11-14: highlight advantageous locations for insertion of digital watermarks; col 14, lines 5-7: measuring, generalizing, altering features determined by relationships between frequency bands (bandwidth consideration) for insertion of watermarks)

(b) steganographically decoding the received information signal to recover the control information; (see Moskowitz col. 3, lines 18-22: decode watermark (control information) from signal)

It would have been obvious to one of ordinary skill in the art to modify Stefik for control information being intertwined with the content portion of the information signal, and in locations based on the available bandwidth of the first communications channel, and steganographically decoding an information signal as taught by Moskowitz. One of ordinary skill in the art would have been motivated to employ the teachings of Moskowitz for the benefits from securely tying copyrights, ownership rights, purchaser information and/or some combination of these and other related data to the content in such a manner that the content must undergo damage during unauthorized distribution of content. (see Moskowitz col 1, lines 41-47)

The term "intertwined" is used within the specification but is not defined within the specification. The Examiner will treat the term intertwine to be equivalent to the term integration. Moskowitz discloses information signal (control information) is integrated with the content.

There does not appear to be any disclosure for a "first" communication channel in the specification or original claims as opposed to a second or any other numerical designation for a communication channel. The first communications channel will be interpreted as a communications channel.

With Regards to Claim 40, Stefik discloses an information signal as in claims 30, 38, wherein comprising control information an indication that the content may be copied only to appliances capable of enforcing the control information. (see Stefik col. 3, lines 59-60: digital works may only be accessed by other secure repositories)

With Regards to Claim 41, Stefik discloses an information signal as in claims 30, 38 in which the control information comprising an expiration date after which the electronic content cannot be used. (see Stefik col 49, ll 55-57: expiration time period for usage rights)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARLTON V. JOHNSON whose telephone number is (571)270-1032. The examiner can normally be reached on Monday thru Friday , 8:00 - 5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-272-4195. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David García Cervetti/
Primary Examiner, Art Unit 2436

Carlton V. Johnson
Examiner
Art Unit 2436

CVJ
June 21, 2010